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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,330	05/20/1998	TORU NAKAMURA	514420-3596	5116

23416 7590 01/20/2004

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/000,330	5/20/98	NAKAMURA	

EXAMINER	
J. DOTE	
ART UNIT	PAPER NUMBER
1756	

DATE MAILED:

**Please find below a communication from the EXAMINER in charge of this application**  
Commissioner of Patents

The amendment document filed on Oct. 14, 2003 (cert. mail. Oct. 9, 2003) (Amdt1014303), is considered to be non-compliant because it fails to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following omission(s) or provision is required. Only the section (1.121(h)) of the amendment document containing the omission or non-compliant provision must be resubmitted (in its entirety), i.e., the entire "Amendments to the claims" section of applicant's amendment document must be resubmitted.

The amendments to claims 21, 22, and 23 are not in compliance with 37 CFR 1.121, because the amendments try to amend claims that are not present in the instant specification.

The immediate prior version of claim 21 does not recite the term "fro" that applicants are trying to delete, but recites the term "from". See claim 21 at page 4 of the amendment filed on Apr. 16, 2001 (Amdt041601), which was entered upon the filing of the CPA on Sep. 14, 2001.

Claim 22 was previously amended in the amendment filed on Dec. 2, 2002 (Amdt120202), which was entered upon filing of the RCE on Mar. 10, 2003. See

Application Control Number: 09/000,330  
Art Unit: 1756

Amdt120202, page 6 and page 8, which presents the marked-up copy of the immediate prior version of claim 22:

22. (Amended Three times) The toner according to claims 16, 17 or 18, wherein the binder resin includes said polyolefin resin with a cyclic structure having an intrinsic viscosity . . . a heat distortion temperature (HDT) by DIN53461-B (January 1987) [August 2, 1995] . . . a proportion of not more [less] than 50% by weight based on the entire binder resin."

The clean copy of thrice-amended claim 22 filed in Amdt120202 mis-labeled the claim as claim 23. Claim 23 was not amended in Amdt120202. The immediate prior version of claim 23 was filed in the amendment on May 3, 2002 (Amdt050302). See Amdt050302, page 4, which presents the clean copy of twice-amended claim 23:

"23. (Amended Twice) The toner according to claims 16, 17 or 18, wherein the binder resin consists of 1 to 100 parts by weight of said polyolefin resin having a cyclic structure, and 0 to 99 parts by weight of at least one resin selected from the group consisting of polyester resins . . . and styrene-acrylate resins."

37 CFR 1.121(a)(2) states that "[w]hen claim text with markings is required. All claims being currently amended shall . . . be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters (emphasis added)."

To ensure an unambiguous record of the claims presented for prosecution, the examiner suggests that claims 22 and 23 be rewritten as new claims with new claim numbers.

Application Control Number: 09/000,330  
Art Unit: 1756

Since the amendment to the claims appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE (1) MONTH from the mailing date of this notice within which to re-submit the corrected amendment to the claims which comply with 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

JLD  
January 10, 2004

*Janis L. Dote*  
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PRIMARY EXAMINER  
GROUP 400  
1700